REMARKS

The last Office Action of October 1, 2008 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 42-73 are pending in the application. Claims 48, 55, 59-73 have been withdrawn from further consideration. Claims 56, 57, 66 have been amended. No claims have been canceled or added. No amendment to the specification has been made.

Claims 56, 57 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 42-47, 49-54, 56-58 stand rejected under 35 U.S.C. §103(a) as being unpatentable over European document EP 0 391 381 A1 to Yoshimoto et al. (hereinafter "EP'381") in view of U.S. Pat. No. 5,328,499 to Poole et al. (hereinafter "US'499") and U.S. Pat. No. 5,049,355 to Gennari (hereinafter "US'355).

Claims 42-44, 46-47, 49, 52-54, 56-57 stand rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-3, 9-11, 15, 16-19 of copending application no. 10/533,850 (hereinafter "PG'850").

Claims 45, 50-51, 58 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-8, 12-14 of PG'850.

REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Applicant has amended claims 56, 57, as suggested by the Examiner, to address the §112 rejection. These changes are self-explanatory and cosmetic in nature and should not be considered as a narrowing amendment to trigger prosecution history estoppel.

Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is thus respectfully requested.

REJECTION UNDER 35 U.S.C. §103(a)

Applicant respectfully disagrees with the Examiner's rejection of independent claims 42, 43, 58 for the following reasons:

The present invention, as set forth in claim 42, is directed to an oxide dispersion strengthened nickel-chromium-iron alloy which is characterized by the presence of oxygen in combination with hafnium which is present as finely divided oxide particles.

EP'381 describes a heat-resistant alloy which is characterized by the absence of oxygen. To bridge the absence of this teaching, the Examiner applies US'499 and submits that the disclosure of oxygen in the involved alloy renders the claim obvious.

In the case at hand, there is no reason for a person skilled in the art to look at US'499 and to find motivation to take the disclosure of, for example, "oxygen" for incorporation into the steel compositions in EP'381, when the US'499 relates to steel composition that is characterized by the presence of tantalum and the presence of yttria which is absent in EP'381 and the present invention.

In general, an alloying ingredient is defined in two ways, namely by material and by quantity, and becomes effective only in concert with other alloying elements because the property of an alloy depends on the type and quantity of all alloying elements. Even though alloys may have same or similar properties, their composition may greatly vary, so that an assumed property of an alloy itself is secondary and cannot be used as basis to formulate a desired composition. In other words, depending on its quantity and the type and quantity of other alloying elements, a particular element may have a positive effect, or a negative effect, or no effect at all. In the case of arsenic, it may have a brittle effect in the steel and impede the hot forming property if there are no other counteracting alloying elements.

Thus, the mere fact that one steel composition contains a particular alloying element by itself means nothing because it develops its effect only in combination with other alloying elements. Thus, an artisan in the field of metallurgy will not look at an alloying element in isolation and assume a particular effect in another steel composition as a result of using this alloying element.

The approach taken by the Examiner to pick and choose among individual portions of various prior art references as a mosaic to recreate a facsimile of the claimed invention is therefore ill-advised. The EP'381 and US'499 references were combined piecemeal without any suggestion or motivation for their combination and without regard to the purpose of applicant's invention. This arbitrary approach demonstrated by the Examiner to simply take one element in isolation from one steel composition that lacks necessary ingredient of another steel composition and contains elements lacking in the other steel composition, and to incorporate this element in the other steel composition goes against common sense so that an artisan at the time the invention was made would not have reasonably considered embedding oxygen within the existing steel composition disclosed in EP'381 in the manner suggested by the examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902.

It is applicant's contention that the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982.

The Examiner readily acknowledged also that EP'381 alloy lacks the presence of hafnium as finely divided oxide particles. To bridge the absence of this teaching, the Examiner applies US'355 and submits that the general disclosure of hafnium oxide in the involved alloy renders the claim obvious. Applicant respectfully disagrees. Independent claims 42, 43, and 58, all set forth the presence of hafnium, whereby at least part of hafnium can be present as hafnium oxide. In other words, the

presence of hafnium as a metallic element as well as the presence of hafnium oxide is set forth. US'355 clearly lacks the presence of hafnium and fails to disclose the percentage of hafnium contained in the alloy composition.

For the reasons set forth above, it is applicant's contention that neither EP'381, nor US'499, nor US'355, nor any combination thereof teaches or suggests the features of the present invention, as recited in independent claims 42, 43, 58.

As for the rejection of the dependent claims on file, these claims depend on claim 42, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Withdrawal of the rejection under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

REJECTION UNDER 35 U.S.C. §101

The Examiner is respectfully requested to hold this rejection in abeyance until such time as at least one claim has been indicated as allowable. It is noted for the record that claims 15-17 have been canceled in PG'850 in the meantime.

REJECTION UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING

A terminal disclaimer may be filed when at least one claim has been indicated as allowable.

CLARIFICATION AMENDMENT

Claim 66 has been amended to properly reflect the unit involved. Reference is made to paragraph [0034] of the instant specification. This amendment is cosmetic in nature and does narrow this claim to trigger prosecution history estoppel.

CONCLUSION

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

The Examiner is also requested to withdraw the election restriction requirement and to rejoin non-elected claims 48, 55, 59-73 because these claims are dependent on a presumably allowable claim or require at least the presence of hafnium, whereby at least part of hafnium can be present as hafnium oxide.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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